



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,182	06/02/1999	AMIT R. SHAH	2870/155	1161

26646 7590 05/28/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

PULLIAM, AMY E

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 05/28/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Appli cation No.

09/324,182

Applicant(s)

SHAH ET AL.

Examiner

Amy E Pulliam

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt of Papers

Receipt is acknowledged of the Amendment E, received by the Office on March 18, 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10-14, 16-19, 21, 22, 24, and 25 remain rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,523,091 to Pastour *et al.* (hereinafter Pastour).

Pastour discloses a cosmetic emulsion composition which comprises a silicone, a gelling agent, and an emulsifying agent (abstract). Pastour teaches that the emulsifying agent can be dimethicone and mixtures thereof (c 1, l 45). Pastour further teaches that the silicone can be a cyclomethicone (c 3, l 18). Pastour also allows for additives such as vegetable oils such as jojoba oil, apricot oil, grape seed oil, and others (c 5, l 1-13), and he also includes surfactants (c 5, l 20), and pigments (c 5, l 44). The reference teaches that the surfactant can be present at between 0.01 – 5% by weight of the composition (c 5, l 24). Pastour also teaches that the composition can comprise active ingredients such as plant extracts, and these can be present from between 1 and 15%. Further, the cosmetic can contain fillers of plants, either inorganic or synthetic, such as starch or

nylon (c 6, 13-11). Lastly, and importantly, Pastour teaches that his composition can be in the form of a mascara.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, and 10-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,523,091 to Pastour *et al.*

Pastour is discussed above as disclosing a cosmetic mascara composition which can contain actives such as plant extracts. Pastour teaches the presence of surfactants, pigments, as well as silicones.

Pastour does not teach the specific percent of extract as claimed in claims 2 and 3. However, the reference does teach a very small and similar amount of extract. As stated above, the reference teaches that the active, such as plant extracts, can be present at between 1 and 15% of the composition. It is the position of the examiner that one skilled in the art would modify the amount of active agent, depending on the specific needs of a particular formulation. Furthermore, it is the position of the examiner that, absent unexpected results, the slight difference between 0.50 and 1.0% does not render patentable distinction to the claims.

Pastour does not teach the specific natural non-plant fiber as claimed by applicant. However, he does teach the inclusion of inorganic and synthetic fillers in general. At

column 6, lines 8-12, Pastour states, "the emulsion according to the invention can also incorporate fillers of plant, inorganic or synthetic origin, in particular starch powder, colloidal silica, nylon powder and talc." This passage allows for the presence of both inorganic and synthetic fillers, and one skilled in the art would substitute any well known filler, known to be successful in mascara compositions, into the composition disclosed by Pastour.

Pastour does not teach the specific surfactant as claimed by applicant. However, Pastour does teach the incorporation of surfactants, in general, into his mascara composition. (as discussed above, see column 5, lines 18-32). The selection of a known material, based on its suitability for its intended use, in obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. Therefore, the selection of a particular surfactant, for use in a formulation which calls for the presence of surfactant, is obvious.

Furthermore, the examiner reads the teaching of plant extract to include any and all plants, as Pastour does not differentiate. Therefore, this teaching includes both vegetables and fruits. One of ordinary skill in the art would have been motivated to make a mascara composition based on Pastour's teachings, which comprises any plant extract, and also contains inorganic or synthetic fillers and surfactants. The expected result would be a successful mascara composition, which has the beneficial qualities of Pastour's composition, which are ease of application, softness, uniformity, hold, and good sensory qualities. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments have been fully considered but are not found to be persuasive. Applicant has amended the claims to include the phrase "of the fruit or vegetable" after the phrase "tacky constituents," which was added into the claims in the prior amendment. Applicant asserts that, in the last action, the examiner stated that the limitation including tacky constituents was not in the claim. The examiner disagrees with this assertion. Looking to the examiner's Response to Arguments in the last office action, it states, "Applicant asserts that the tacky components of the fruit or vegetable are not separated or purified to make the whole processed fruit or vegetable extract, and that the pulp and skin are present in the extract of the present invention. The examiner points out that neither of these limitations is present in the instant claim language, and are therefore not considered in determining patentability." The portions that are not in the claim language are (1) that the tacky constituents of the fruit or vegetable are not separated or purified to make the whole processed fruit or vegetable extract, and (2) that the pulp and skin are present in the extract of the present invention. These limitations are much more substantial than limitations which were added to the instant claims. Furthermore, the phrase "tacky constituents" was in the claim prior to the last amendment by Applicant. The only addition to the claim was "of the fruit or vegetable." This limitation does not further define the claim, as suggested by the Examiner.

Applicant again argues that the term "extract" is defined to have a special meaning, such that the extract is prepared using a seedless but otherwise whole fruit or vegetable. This is not the same way this limitation is found in the instant claims. The instant claim states "substantially whole" rather than "whole". These can be interpreted

Art Unit: 1615

very differently, because substantially whole can be interpreted to mean portions of the plant have been removed, and it may still be considered “substantially whole.” Applicant again asserts that “the tacky components of the fruit or vegetable are not separated or purified...” and that the “nuance of the present invention is the substantially whole processed fruit or vegetable extract whereby the pulp and skin are present in the extract of the present invention.” Again, these two specific, and by Applicant’s own admission, important limitations are not present in the instant claim language.

Applicant further argues that the plant extract of the Pastour reference is not the same as the plant extract of the present invention. Applicant asserts that the plant extract is therefore an active principle isolated from the plant. The examiner finds no support for this assumption anywhere in the Pastour reference. The examiner invites Applicant to point to the citation within the reference which confirms this statement, that the Pastour active is isolated from the plant. The examiner refers again to the following passage of Pastour, “[i]t can also comprise active principles such as plant extracts...” This passage contains no statement that the active is isolated from the extract, is simply discloses the inclusion of a plant extract.

The examiner restates an important observation present in the previous office action. As stated by applicant, in the instant specification, the term extract is defined to have this special meaning such that the extract is prepared using seedless but otherwise whole fruit or vegetable. This does not mean that the extract is a substantially whole processed fruit or vegetable, it simply means the extract came from a substantially whole processed fruit or vegetable.

Furthermore, Applicant continues to argue that the reference does not teach plant extracts, but instead teaches the active principle of a plant extract. The examiner again disagrees. As stated by applicant, the reference teaches active principles such as plant extracts. This does not mean the active from within the plant extract, it means that the reference considers the plant extract to be an active principle.

Applicant argues that the reference does not teach silicone oil. However, the examiner points to the disclosures of dimethicone and cyclomethicone, discussed above in the anticipation rejection.

Applicant again argues that the examiner is incorrect in the assertion that the results of applicant's invention are not unexpected. Applicant contends that the ability of their mascara to perform as well as conventional mascaras is unexpected because their invention contains substantially whole or unprocessed fruit or vegetable extracts. It is the position of the examiner that adding additional ingredients to a traditional formulation, and discovering that it works just as well as the known formulation, is indeed not unexpected. Regardless, the prior art achieves the same result as Applicant, a successful mascara formulation. Therefore, there is no showing unexpected results.

It remains the position of the examiner that applicant's broad claim to a fruit or vegetable extract has not been differentiated from the known art-related use of the term extract. It is the recommendation of the examiner that applicant place the specific fruit and vegetable extracts being used, into the independent claims. It is further the position of the examiner that applicant insert into the claim, all the terminology used in the arguments, to differentiate between applicant's extract and the art's extract. These additions will help advance prosecution towards an allowance.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Art Unit: 1615

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A. E. Pulliam
Patent Examiner
Art Unit 1615
May 22, 2003


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600